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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10 020,219 | 12 18 2001 | Masayuki Ikeno | 217555US0 | 5739 |

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

ROBERTSON, JEFFREY

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1712

DATE MAILED: 05 23 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,219

Applicant(s)

IKENO ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities: For claim 5, the claim depends from claim 4, which has been cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaiya et al. (U.S. Patent No. 6,545,076).

The examiner is applying this patent as a result of a search update. It is noted that this reference had previously been published as a US Patent Publication. The examiner apologizes for not bringing this reference to applicant's attention earlier. Also, applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

For claims 1 and 3, in column 2, lines 3-19, Kaiya teaches a diorganopolysiloxane having at least two alkenyl groups in a molecule, that has a

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viscosity of 50-5,000 mPa.s (0.05-5Pa.s), which corresponds to applicant's component (A). Here, Kaiya also teaches the presence of two different organohydrogenpolysiloxanes corresponding to applicant's components (B) and (C). Kaiya also discloses the presence of a platinum-type hydrosilylation catalyst. For claims 1 and 5, for applicant's component (B), in column 2, lines 58-67, Kaiya teaches that the component (b-1) contains a diorganopolysiloxane having hydrogen atoms on both its terminals. In column 3, lines 1-2, Kaiya teaches the same viscosity range set forth by applicant for the corresponding component (B). In column 5, lines 2-4, Kaiya teaches a polymer that falls within applicant's definition where there is one hydrogen bound to each terminal silicon atom, and where the rest of the groups on the polymer are methyl groups also fulfilling the requirement that there are no alkenyl groups present. For applicant's component (C), in column 3, lines 3-16, Kaiya teaches that in the component (b-2), there are at least three silicon-bonded hydrogen atoms present and that the component has a viscosity within the same range set forth by applicant.

For claim 2, in column 4, line 66 through column 5, line 2, Kaiya discloses a copolymer of methylhexenylsiloxane and dimethylsiloxane that is capped with dimethylhexenylsiloxo groups, triorganosiloxo groups. Since this copolymer contains repeating diorganosiloxane units, it is a substantially straight chain diorganopolysiloxane.

For claim 6, in column 5, lines 5-7, Kaiya discloses the component (b-2) as a methylhydrogenpolysiloxane capped with trimethylsiloxo groups. This corresponds to the formula units set forth by applicant and the third structure of claim 6, where both R

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and X equal methyl and also fulfills the requirement that there are no alkenyl groups present. For components (E) and (F), in column 3, lines 46-61, Kaiya discloses that a non-functional polysiloxane having a viscosity significantly overlapping the range set forth by applicant and that powdered silica fillers (dry process silica) can also be added. In column 5, lines 15-18, Kaiya teaches a composition that has a ratio of silicon-bonded hydrogen to silicon alkenyl groups of 1.1, which is within the range claimed by applicant.

For claims 1 and 7, in column 5, lines 2-7, Kaiya teaches that the amount of hydrogen in (b-1), which corresponds to applicant's component (B) provides 41% of the hydrogen in the composition, which is within applicant's range. The calculation used by the examiner was:
$$\frac{(13.8 \text{ parts (b-1)})(0.0012 \text{ hydrogen (b-1)})}{[(13.8 \text{ parts (b-1)})(0.0012 \text{ hydrogen (b-1)}) + ((1.5 \text{ parts (b-2)})(0.16 \text{ hydrogen (b-2)))]} \times 100.$$

For claim 9, Kaiya teaches in column 3, lines 32-45, that the platinum catalyst is present in an amount of 1 to 1,000 ppm, significantly overlapping the range set forth by applicant. In column 5, lines 12-15, Kaiya teaches 200 ppm of platinum, which is within applicant's range.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3, and 5-10 have been considered but are moot in view of the new ground(s) of rejection.

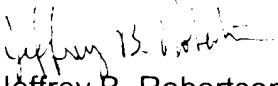
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Examiner
Art Unit 1712

JBR
May 22, 2003